

REMARKS

The subject application has been carefully considered in view of the Examiner's Action of December 23, 2003. Accordingly, Claims 22-25 have been cancelled so the claims now remaining in the case are Claims 1-21 and 32-36. Claims 1, 32, 34, 35 and 36 have been amended. In particular, the pocket insert of Claim 1 is now defined as having a base sheet which is the same size (length and width) as a book page and that "two ply seams" form the pocket between the base sheet and pocket sheet.

Claims 32 and 34 are amended to recite that the seam attaching the base sheet to the pocket sheet is "continuous" and that the insert has a thickness "rendering it passable through a copier or printer in sequence with a sheet of paper".

Claims 35 and 36 provide that the thickness of the pocket insert renders the insert able to pass through a copier or printer in sequence with single sheets that are comparable in size to the insert.

1. Claim 35 stands rejected under 35 U.S.C. 102(b) as being anticipated by Michlin (US 5, 141, 252). For a rejection under 35 U.S.C. 102 (b) to stand, each element of the claim must be found in a single reference. This is not the case here.

Michlin is said to disclose a pocket insert "capable of passing through a printer" (Col. 3, lines 15-18). However, a close reading of the cited passage indicates only that the back ply 16 of the insert "can be preprinted". Saying it can be "preprinted" leaves open the printing sequence; that is, does "preprinting" of the back ply occur before the insert is made or after? It also lacks specificity as to whether the entire insert is passable through a copier or printer.

Saying the back ply "can be preprinted" is a far cry from saying that the insert as a whole is passable through a copier or printer. Nor is there any disclosure in the reference of an ability of the insert to pass through a copier or printer "in sequence with a single sheet of paper". These features, either explicit or implicit in the unamended claim are not disclosed by the reference.

However, for purposes of clarification, Claim 35 is amended to include a positive recitation of the insert thickness. In this respect, the claim now defines the insert as having a "thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having the given width and length".

Since the reference is silent both as to whether the insert itself (not just the back ply) is passable through a copier or a printer, or whether the insert thickness renders it (the entire insert) passable through a copier or printer in sequence with a single sheet, the rejection under 35 U.S.C. 102 (b) cannot stand.

2. The Examiner's Action essentially repeats the rejection of Claims 1-9, 11-13, 16-18, 22-23, 25, 32 and 34 under 35 U.S.C. 103(a) as being unpatentable over Wyant (US 5, 823, 573) in view of Dick (US 1, 495, 953). Claims 22-25 are cancelled.

Claim 1 as amended recites that the seams forming the pocket are "continuous two ply seams defining a closed pocket". Applicant's prior remarks pointed out that the primary reference, Wyant, discloses a structure where the "pocket" has an open bottom (see Appeal Brief, page 4) so there is a through passage as opposed to a "closed pocket". In addition, it is clear from the Wyant figures that at least the side seams are three plies thick and not two as claimed.

The Examiner has a further list of claimed structural elements not disclosed by Wyant. All the missing elements are said to be disclosed by Dick and that it would be obvious to modify the Wyant pocket insert in view of Dick to provide the claimed invention. Applicant respectfully disagrees.

- The Dick recitation of "stitching or securing means" does not render obvious the claimed "chemically bonded, fused or glued" construction. This is particularly the case as the seams in Dick are three ply (as are the side seams of Wyant) and not the claimed two ply structure.
- As noted in Applicant's Appeal Brief, modifying Wyant to incorporate features of Dick would render the Wyant article

inoperative. This is because a closed pocket eliminates the tabs 12, which are essential to the Wyant insert.

- Drawing on the teachings of Dick also would have the pocket opening not face the binding edge as claimed.

For at least these reasons the teachings of Dick simply cannot cure the deficiencies of Wyant.

Independent Claim 32 as amended identifies the attachment of components to be "along a continuous seam to form a closed end pocket". The pocket opening is defined as facing "the binding" and the total thickness of the pocket insert as "less than a combined thickness of the base sheet, the pocket sheet and one of the base sheet and the pocket sheet" (that is, the insert is less than three plies thick). This construction renders "the insert passable through a copier or printer in sequence with a sheet of paper".

The proposed combination of Wyant and Dick renders the primary reference inoperative as noted above in that a continuous seam would eliminate the essential tabs 12 of Wyant. Even so, the proposed combination would have seams that are at least three plies thick (rather than having an effective thickness less than three plies as claimed) and openings that do not face the binding. Nor is there any suggestion in the references themselves of an insert that is "passable through a copier or printer" as claimed.

Claim 34 is amended along the lines of Claim 32, so the arguments as noted above apply equally to Claim 34.

Dependent claims 8-9, 11-13 and 16-18 include all the limitations of their respective independent claims, so they can be distinguished for at least the reasons noted above.

3. Claims 10, 14, 15, 19-21, 24 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wyant in view of Dick and further in view of Ruebens (US 4, 965, 948). Ruebens is cited as teaching an adhesive strip for the purpose of denying a plurality of pockets to hold numerous items.

Claims 10, 14, 15 and 19-21 depend from Claim 1 and therefore include all the limitations thereof, so the arguments made in response to the rejection of

Claim 1 are repeated. In addition, it is noted that the Ruebens' teachings concern a transparent plastic album insert 22 and not "paper material" as set out in Claim 1. Further, the Ruebens' disclosure is no more relevant than Dick in that Ruebens, like Dick, teaches seams that are three ply and not the two ply construction as set out in Claim 1.

Independent Claim 36 is distinguished in that it calls for "a seam of two plies". Both Wyant and Ruebens disclose structures wherein at least portions of the seams are three plies. Claim 36 further is amended to recite that the insert has "a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having a width and length comparable to the base sheet width and length". None of the references suggest a pocket insert passable through a copier or printer, let alone a pocket insert that is passable through a copier in sequence with a single sheet having the same size as the insert base sheet.

As noted in the specification, an insert passable through a copier or printer in sequence with a single sheet of comparable size facilitates assembly of a book or the like by allowing the insert to be included with a stack of single sheets that are run through a copier or printer prior to binding.

Accordingly, in view of the above amendments and comments, the claims remaining in the case are in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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